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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 847,892	05 02 2001	Joseph F. Walsh	35006-00019C1P	7516

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EXAMINER

LE. THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06 10 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,892

Applicant(s)

BOYDSTON ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 24-63 is/are allowed.
- 6) ☐ Claim(s) 1-23 and 64-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed on 2/27/2003 has been entered. Claims 1-86 remain for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 7-8, 64-65, 67, 69-70, are rejected under 35 U.S.C. 102(b) as being anticipated by Hale et al. (herein Hale – 4,689,478).

Hale discloses a hand-held terminal which may be used for handling a wide variety of financial, shopping, and other transactions. According to Hale, the personal terminal is credit-card sized, is intelligent, includes a plurality of transaction totals and is constructed to be user-friendly. An interface module is used to couple the terminal to other systems for on-line uses.

Figure 3 of Hale shows a plan view of the P Terminal 12 when it is in an "initial" mode of operation. The P Terminal 12 is shown slightly larger than full size in FIG. 3, which size is about equal to that of a credit card; the P Terminal 12 is less than 1/4 inch thick in the embodiment described. The P Terminal 12 has a semi-flexible, top panel 24 which functions as both a display and a keyboard. When viewing the top panel 24 as a display, there are display elements or pixels which are distributed over the panel

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24 in a pattern that is appropriate to display information to the user. The panel can be viewed as having nine line displays 26-1 through 26-9 which will be collectively referred to as display 26. A single string of large alphanumerics can be displayed in a line display like 26-1, or a double string of smaller alphanumerics can be displayed in a line display like 26-3.

Hale further discloses that the P Terminal 12 can be used in relation to a POS transaction involving a grocery store. It can also be used to purchase gasoline at an automatic gasoline terminal or may be used with other POS terminals like those used for the purchase of tickets, for example.

According to Hale, the P Terminal 12 is that it may be used with a terminal 162 which may be a personal computer (PC). The terminal 162 (PC) may be supplied with a program for handling "Home Payment" transactions, for example. With such a system, the terminal 162 (PC) may be connected to a host system via the telephone lines to provide the terminal 162 (PC) with the monthly bills to be paid by the user. Naturally, those companies wanting to be paid in this way would become part of the system for "Home Payment". The user would then use his P Terminal 12 in conjunction with the terminal 162 PC, and the user would operate the P Terminal 12 as described in relation to a POS transaction already described. If the terminal 162 (PC) did not have a MODEM, the MODEM associated with the P Terminal 12 (FIG. 15) could be used. For example, FIGS. 24, 25, and 26 show certain of the displays and options presented to the user from his P Terminal 12 when operating it in a "Home Pay" transaction. In this regard, the display 26 shows the amount of the payment to be

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made as \$52.00 on display line 26-2 of FIG. 24; an earlier display (not shown) would have indicated that this payment was for Shillito Rike's Department Store. In the example described, assume that the user wishes to pay for this bill from his VISA account; accordingly, the user actuates the key area 28-6 (FIG. 24) which corresponds to "VISA" being displayed on display line 26-6.

Hale further discloses that the payment of bills can be effected without having the personal computer. According to Hale, the payment can be effected through using the P Terminal 12, and the I Module 14 which includes the configuration shown to the left of line B--B in FIG. 12, including the MODEM 120. In this situation, the initial mode of the P Terminal includes an option called "AUTO DIAL". When this option is selected, the P Terminal 12 and the I Module 14 become connected to the host system by the telephone lines. After verification of the user's PIN and account numbers as previously described, a menu such as that shown in FIG. 27 is presented to the user. Notice that display line 26-1 indicates that the P Terminal 12 and the I Module 14 are on an on line system with the host system and that the menu indicates a partial list of those companies which are part of the system for making home payment by electronic funds transfer. If the user wishes to pay his gas utility bill, he actuates the key area 28-6 (FIG. 27) to start the sequence of activities already explained in relation to FIGS. 20, 21, 22, and 23.

As can be seen from above, Hale discloses a hand-held terminal which can be directly or indirectly coupled to a host server/bank server via telephone lines for conducting financial transactions, fund transfers, ticket purchasing, etc. The hand-held

terminal includes a keypad/keyboard for accepting user's requests/inputs for conducting transactions. Hence, Hale discloses the claimed invention.

Regarding claim 2, the terminal as described above includes a keypad/keyboard for accepting financial and personal data from a user and thus would embrace all limitations set forth in this claim.

Regarding claim 4, see the discussions above regarding claim 1. Specifically, Hale discloses that the terminal 12 can be directly connected to a telephone line via an associated modem (see Fig. 15).

Regarding claim 5, Hale discloses in a preferred embodiment that the terminal 12 requests a user to enter his PIN number in order to conduct transactions (see Fig. 18 and its descriptions).

Regarding claims 7-8, Hale discloses that the P Terminal 12 carries the various balances associated with the user's various accounts and updates them to reflect transactions which he effects. If the user is satisfied with his intended payment, he actuates the key area 28-8 (FIG. 22) next to "ACCEPT" on line display 26-8 to effect the transaction. The transfer of funds from the user's account to that of the "Foodtown" store in the example described is effected immediately if the terminal 162 is on line with the host system or it may be done later if the terminal is not on line (see Fig. 22 and its descriptions). As can be seen, Hale discloses that transactions can be saved in a memory of the terminal 12 in order to be conducted at a later time; and thus would embrace all limitations set forth in this claim.

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Regarding claims 64-65, 67, 69-70, see the discussions above regarding claims 1-2, 4-5, 7-8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 6, 9-23, 66, 68, and 71-86, are rejected under 35 U.S.C. 103(a) as being obvious by Hale et al. (Hale – 4,689,478; cited above).

Regarding claims 3, 6, 9-23, 66, 68, and 71-86, the system as taught by Hale has been discussed above. Though Hale mentions that the terminal 12 can be used in POS application, he is silent about the use his system with a card reader/bar code reader, and various variations and combinations including: memory, card reader, low-power proximity detector, magnetic card, audio input/output ports, etc. It would have been obvious to incorporate these features in the system as taught by Hale. The use of each and combination of these features in POS systems and environments are known in commercially available in POS systems. For example, the use of proximity detector has long been used and developed by many scanner manufacturers, including: Symbol Technologies; Spectra Physics Corp.; Norand; Metrologics; etc. Further, magnetic card reader and audio input/output ports have been incorporated in self-checkout and POS environments. Without any unexpected result, and in light of Hale's suggest for using his system with a POS system, the modifications are merely design considerations which are well within skill levels and expectations of an ordinary skilled artisan.

Allowable Subject Matter

Claims 24-63 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose handheld unit for transmitting requests and receiving responses to/from a server comprising:

A number of input components;

A processing component;

A transceiver;

A number of output components;

And having the features, functions and characteristics as recited in claim 24.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-

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3500. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Le, Thien Minh
Primary Examiner
Art Unit 2876
May 31, 2003